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In re Patent No. 7,125,907 :
Issued: October 24, 2006 :
Application No. 10/791,278 : ON PETITION
Filed: March 3, 2004 :
Attorney Docket No. 054707-1263 :

This is a decision on the petition under 37 CFR 1.182 filed June 15, 2006, to change the order of inventorship in the above-identified patented file.

The petition is **DISMISSED**.

Judge Schall in *Fina Technology Inc. v. Ewen*, 60 USPQ2d 1314 (CA FC 2001), stated:

Whenever a mistake of a clerical or typographical nature, or of minor character, which was not the fault of the Patent and Trademark Office, appears in a patent and a showing has been made that such mistake occurred in good faith, the Director¹ may, upon payment of the required fee, issue a certificate of correction, if the correction does not involve such changes in the patent as would constitute new matter or would require re-examination. Such patent, together with the certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form. Section 255 does not provide for action by a district court.

¹ Effective March 29, 2000, the title of the head of the Patent and Trademark Office ("PTO") was changed from "Commissioner" to "Director." Pub. L. No. 106-113, 113 Stat. 1501A-582 (1999). Although the district court and the parties refer to the head of the PTO by using the title "Commissioner," we use the term "Director" to avoid confusion with the current statutory language.

Rather, the statute permits only the Director to issue a certificate of correction for a clerical error. Furthermore, the order of inventorship does not appear to be the type of mistake contemplated by §255. Examples of mistakes that fall under §255 typically include correcting a misspelled word or adding a prior art reference that was submitted to and discussed by the examiner but inadvertently omitted by the applicant on PTO Form 1449 for listing references. See *In re Arnott*, 19 USPQ2d 1049, 1053 (Comm'r Pat. 1991). The order of inventors in the heading of a patent is taken by the PTO directly from the order in which the names appear in the original oath or declaration. Man. Pat. Exam. P., §605.04(f) (7th ed. rev. 1 2000). According to the Manual of Patent Examining Procedure, "no changes will be made [by the Director to the order of inventors] except when a petition under 37 C.F.R. 1.182 is granted."² Id. In short, the order of inventors is not a clerical error contemplated by § 255, and cannot be corrected in a judicial proceeding under that provision.

It is not problematic for district courts to lack the authority to correct the order of inventors because "the particular order in which the names appear is of no consequence insofar as the legal rights of the joint applicants are concerned." Id. As we stated in *Fina I*, "if the inventors are properly named on the patent, Fina has no concerns about invalidity of the patent over inventorship problems." 123 F.3d at 1471, 43 USPQ2d at 1940.

² 37 CFR 1.182 (2000) concerns situations that are not specifically provided for in other regulations and authorizes the Director to decide each case that arises in accordance with the merits of the situation.

In view of the above, since the order in which the names appear on the printed patent is of no consequence insofar as the legal rights of the joint applicants are concerned, and since there was no clerical error as contemplated by 35 U.S.C. 255, the petition under 37 CFR 1.182 to change the order of inventorship in the above-identified patent must be dismissed. Accordingly, no certificate of correction will be issued to reflect the desired order of inventorship.

Any questions concerning this decision may be directed to Alesia M. Brown at (571) 272-3205.

This application is being returned to Files Repository.



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